Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte AKIHITO TAKASAKI and KENICHIROH KAMEI

Appeal No. 2001-1465
Application No. 09/048,522

ON BRIEF

Before COHEN, McQUADE and BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-12. Claims 13-20, the only other claims pending in this application, stand withdrawn from consideration pursuant to 37 CFR § 1.142(b).

BACKGROUND

The appellants' invention relates to "an apparatus for cutting individual belts from a belt sleeve having alternating ribs and grooves on a surface thereof to produce belts of uniform, predetermined width and cross-sectional configuration" (specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The examiner relied upon the following prior art references in rejecting the appealed claims:

Spivy	4,248,110	Feb. 3, 1981
Taguchi	4,700,597	Oct. 20, 1987
Lundgren	4,833,957	May 30, 1989
Lüber	5,079,874	Jan. 14, 1992
Noé	5,381,342	Jan. 10, 1995
Aihara et al. (Aihara)	5,906,148	May 25, 1999[1]

The following rejections are before us for review.

(1) Claims 1, 2 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Spivy in view of Noé.

(2) Claims 1, 2 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Spivy in view of Noé and Lundgren.

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[1] Filed Feb. 20, 1997.

(3) Claims 3, 4, 6 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Spivy in view of Noé, as applied to claim 1, and further in view of Lundgren.

(4) Claims 5 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Spivy in view of Noé and Lundgren, as applied to claim 1, and further in view of Lüber.

(5) Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Spivy in view of Noé and Lundgren, as applied to claim 1, and further in view of Taguchi.

(6) Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Spivy in view of Noé and Lundgren, as applied to claims 1 and 2, and further in view of Aihara.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 15) for the examiner's complete reasoning in support of the rejections and to the brief (Paper No. 14) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the

respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Spivy, the jumping off point for the examiner's determination of obviousness in each of the rejections before us, discloses an apparatus for cutting a belt sleeve 21 utilizing a high velocity liquid jet 31 issued from a jet nozzle 30. The apparatus comprises a pair of cylinders 22 for supporting and rotating the belt sleeve and "suitable moving means" (column 4, lines 32-33) for moving the jet nozzle 30 axially along the belt sleeve 21. The examiner concedes (answer, page 4) that Spivy does not disclose an imaging subassembly and control system as called for in independent claim 1.

Noé discloses a system for trimming a continuously moving metal strip 1, including optical edge-position detectors 6, a sensor 7 for measuring the width B of the strip, a web-speed detector 8, a processor 9 which calculates from the outputs of sensors 7, 8 how much material must be trimmed off the strip edges to produce a desired finished workpiece width and a control unit 10 which controls head positioners 3 to move trimming heads 4 independently of each other to trim the edge as needed based upon the output of the processor 9. An upstream monitoring station 20 further monitors irregularities in both longitudinal edges of the strip and transmits that information to the processor 9. The control of the trimming heads is effected such that the edge strip E trimmed from both sides is maintained continuous. While this results at times in trimming of the workpiece to a width which is too narrow, Noé considers it

preferable to create a workpiece reject than to have to shut down the production line (see column 1, lines 30-49; column 4, lines 54-58).

Lundgren disclose an optical imaging system for detecting deviations in the direction of transverse elements of fabric strips caused by distortions resulting from local tensioning applied by the cutting machine and for moving the cutter means and strip "to enable the cutter means to cut the strip substantially along a single transverse element and at least substantially avoid cutting of transverse elements, despite skewing or bowing of such transverse elements from perpendicularity with the length direction of the strip" (column 2, lines 29-34).

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Further, rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967).

While both Noé and Lundgren are directed broadly to imaging systems used in combination with cutters, we perceive no teaching or suggestion in these references to

provide an imaging subassembly and control system for monitoring and controlling the relationship between the location of the cutting jet 31 of Spivy and a predetermined cutting location as recited in claim 1. From our perspective, the only suggestion for putting the selected pieces from the references together in the manner proposed by the examiner is found in the luxury of hindsight accorded one who first viewed the appellants' disclosure. The examiner's rejections of claim 1, as well as claims 2 and 7 which depend from claim 1, as being unpatentable over Spivy in view of Noé or Spivy in view of Noé and Lundgren are thus improper and cannot be sustained. In light of our discussion *supra*, it also follows that the examiner's rejection of claims 3, 4, 6 and 11, which also depend directly or indirectly from claim 1, as being unpatentable over Spivy in view of Noé and Lundgren cannot be sustained.

The above-noted deficiency of the combination of Spivy, Noé and Lundgren finds no cure in the teachings of the additional references relied upon in rejecting the remaining dependent claims on appeal. Thus, the rejections of claims 5 and 12 as being unpatentable over Spivy in view of Noé, Lundgren and Lüber, claims 8 and 9 as being unpatentable over Spivy in view of Noé, Lundgren and Taguchi and claim 10 as being unpatentable over Spivy in view of Noé, Lundgren and Aihara are also not sustained.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-12 under 35 U.S.C. § 103(a) is reversed.

REVERSED

IRWIN CHARLES COHEN Administrative Patent Judge	)
JOHN P. McQUADE Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)

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